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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,531	10/15/1998	Ralph M. Ellison	7409-150-999	1947

7590 07/16/2003

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EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/16/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n No.

09/173,531

Applicant(s)

ELLISON ET AL.

Examin r

JOHN D PAK

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

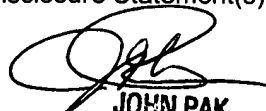
Claim(s) allowed: _____.

Claim(s) objected to: 4-12 and 24-29.

Claim(s) rejected: 1,2,4-8,10-12,14-17 and 21-29.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


JOHN PAK
PRIMARY EXAMINER
GROUP 1000

Continuation of 2. NOTE: The amendment form is poor. In claims 10, 11, 12, 24-29, a dash mark is placed over commas. This is confusing. If applicant intended to delete or cross out the commas, hand correction is suggested. Present version of the amendment would be confusing to subsequent processing.

Continuation of 10. Other: (1) Rejection of the claims stand, particularly with respect to the broader claim directed to cancer of the "central nervous system." Sufficient evidence has been presented vis-à-vis such subject matter, in particular, prior art treatment of diverse types of solid tumors and broad teachings of "in vivo cancer entities" including lymphatic cancer, which is known to spread to CNS.

(2) In claim 9, a spelling mistake is noted -- correct spelling should be "oligodendroglioma".

(3) Claim 9 still depends on a canceled claim.

(4) The use of the term "pro drug" in relation to arsenic and cancer should be reconsidered by applicant. Attached is a very extensive search in numerous scientific databases such as the PTO patent database (WEST), Chemical Abstracts, Medline, Embase, Cancerlit, Uspatfull and Pctfull databases. Except for applicant's own work and a PCT publication published in May 2003, there is no scientific disclosure of arsenic pro drugs. If applicant does not reconsider the use of the term "pro drug," the Examiner may have to reconsider his position with respect to a new ground of rejection. Final determination will be made when applicant submits an acceptable amendment for entry.